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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,404	06/23/2003	Larry Randall Daudet	98356CONCONCON	7735
26285	7590	07/10/2006	EXAMINER	
KIRKPATRICK & LOCKHART NICHOLSON GRAHAM LLP			CHAPMAN, JEANETTE E	
535 SMITHFIELD STREET			ART UNIT	
PITTSBURGH, PA 15222			PAPER NUMBER	
			3635	

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/601,404	Applicant(s) DAUDET ET AL.	
	Examiner Chapman E. Jeanette	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-10 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

35 USC 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heydon (5353560) in view of Frobosilo et al (5687538) and Liss (5956916). Heydon discloses an apparatus for supporting a plurality of joist, figure 8. The apparatus comprising:

- A joist rim having
 - A web 46
 - First and second rim legs 48
- At least one opening through the web; see figure 7
- A joist attachment tab 58 integrally formed in the web adjacent each said opening; each of the tabs 58 extending from the web at an angle relative to the web
- The angle between each tab and the web is 90 degrees
- Each joist attachment tabs 58 has a plurality of fastener holes there through 60
- Fastener holes 53 in the first and second legs
- Fastener holes 51 in the webs

Heydon clearly show openings through the web but not specifically disclose the same as does the joist 9 of Liss. The joist of Liss includes a tab and an opening 11 through the web. Specifically the tab comprises a portion of the web bent outward from another portion of the web at an angle. It would have been obvious to one of ordinary skill in the art to modify Heydon to include the opening through the web providing a convenient means to form the tab while strengthening the structure of the web as shown by Liss.

Heydon lacks the reinforcing rib corresponding to each of the tabs and provided in each said web adjacent said corresponding tab. Frosbosilo et al discloses a joist with reinforcement ribs 74a/76/78 adjacent the opening 60. Frosbosilo et al includes at least one other reinforcing rib 74a adjacent each opening. The reinforcing ribs comprise indentations that are embossed on a surface of the web. See column 5, lines 10-45. It would have been obvious to one of ordinary skill in the art to modify Heydon to include the ribs adjacent the openings 60 to improve the resistance to stress distortion and torsional stress distortion as taught by Frosbosilo et al. With the vertical ribs added, the vertical surface of the rib would be parallel to the tab.

Response to Arguments

Applicant's arguments filed 4/25/2006 have been fully considered but they are not persuasive. Applicant is arguing function, motivation to combine and what is not recited. Applicant can not state that the same limitations by the prior art will not cause the structure to act identically to applicant's having the same limitations. First, however, applicant argues that there is no motivation to combine since heydon's header or footer joist is supported by the floor . Hence there will be no concerns of buckling or deflection. Applicant erroneously arrives at this conclusion. There will not be as much buckling or deflection or the same degree of buckling or deflection. These ribs are known in the art of building structures and are used to impart strength to the structure wherever it is desired. It is not clear regarding the arguments against Liss. Liss clearly shows a header joist 9 with an attachment tab 6 and an opening 11 next to the tab. The tab includes apertures for fasteners 8 to attach the tab 6 to the joist 4. See figures 4-6. The cost is not relevant here since the prior art clearly shows the structure and one of ordinary skill in the art would have been motivated to modify Heydon to include the opening through the web providing a convenient mean to form the tab while strengthening the web structure as shown by Liss. Therefore, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*,

837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation came from within the knowledge of the art for Liss and from the reference itself of Frobosilo et al. Again, one can not argue there will be no deflection or buckling with Heydon.

On page 3 of applicant's response/request for reconsideration/arguments, beginning with the first full paragraph, applicant argues the differences between Heydon and the recited invention. However, these differences are not recited to make the claims distinguishable from the prior art. The supposed distinctions or differences are not recited to make render the claims not obvious over the prior art.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no motivation to combine, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.

In response to applicant's argument that there is no motivation to combine and that the prior art references have different uses and functions, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly

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suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chapman E. Jeanette whose telephone number is 571-272-6841. The examiner can normally be reached on Mon.-thursday, 8:30-6:00, every fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Friedman Carl can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JEANETTE CHAPMAN
PRIMARY PATENT EXAMINER
ART UNIT 3635
